

Application No. 10/608,545
Amendment Dated June 29, 2005
Reply to Office Action of April 13, 2005

REMARKS/ARGUMENTS:

By the present Amendment, claim 48 is canceled. No new matter has been added. Claims 41 – 47 and 49 51 are currently pending in the application, with claims 41 and 49 being independent.

Applicant has carefully considered the contents of the Office Action and respectfully requests reconsideration and reexamination of the subject application in view of the explanations noted below.

Rejections under 35 U.S.C. § 112 (second paragraph)

Claims 42 and 48 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. Specifically, claim 42 is alleged to lack antecedent basis for the recitation of “the optical axis of the eye” and claim 48 is alleged to be vague.

Claim 42 recites “the optical axis of the eye” in line 2. The preamble of claim 41, from which claim 42 depends, recites “the eye having a cornea with an external surface and an optical axis.” Since claim 41 clearly recites an eye having an optical axis, the recitation of “the optical axis of the eye” in claim 42 has proper antecedent basis. Therefore, the rejection of claim 42 under 35 U.S.C. § 112, second paragraph, is improper and should be withdrawn.

Since claim 48 has been canceled, the rejection of claim 48 under 35 U.S.C. § 112, second paragraph, should be withdrawn.

CLAIM REJECTIONS UNDER 35 U.S.C. § 102(b)

In paragraph 7, claims 41 – 43, 49 and 50 are rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,964,748 to Peyman (the Peyman ‘748 patent).

Applicant respectfully traverses this rejection, since the Peyman ‘748 patent clearly does not disclose, teach or render obvious the subject matter of claims 41 – 43, 49 and 50.

Independent claims 41 and 49 each recite, inter alia, a first lens with a first opening and a second lens with a second opening, and the second lens being substantially concentric with the first lens.

Independent claim 41 further recites, inter alia, that the first and second lenses are both substantially centered about the optical axis of the eye.

The Peyman '748 patent discloses a method of modifying a live cornea to correct a patient's vision. Ocular material or implant 1130 is placed between first and second internal surfaces 1122 and 1124, as shown in FIG. 80. The ocular implant 1130 may have a substantially annular ring shape with a center opening or circular hole similar to the implant 430 shown in FIG. 41. Modifications of the ocular implant 1130 are shown in FIGS. 82 – 85. The implant 1130' of FIG. 82 has a slit 1131' therein to facilitate installation of the implant under the corneal flap 1126. The implant 1130" of FIG. 83 is a two-piece implant and the implant 1130''' of FIG. 84 is a three piece implant. As shown in FIG. 85, the multi-piece ocular implants may use a snap-fit joint to connect the ends thereof. The Peyman '748 patent does not disclose or suggest disposing multiple ocular implants concentrically to one another as recited in Applicant's independent claims 41 and 49.

FIG. 83 allegedly shows first and second lenses concentrically disposed and substantially centered about the optical axis, as diagrammed on page 4 of the April 13, 2005 Office action. The diagram indicates that each of the two arcuate portions of the implant corresponds to one of the claimed lenses. The center of the implant is designated as the common center/axis. The portion in front of the inner edge of each arcuate portion is indicated as corresponding to an opening/aperture.

The arcuate portions of the implant shown in the diagram on page 4 of the Office action (FIG. 83 of the Peyman '748 patent) clearly do not have an opening therein or an aperture therethrough, as recited in independent claims 41 and 49. The diagram in the Office action clearly shows the opening/aperture being spaced from the arcuate portion itself. Independent claims 41 and 49 clearly recite that the opening or aperture is in the lens itself. Thus, the Peyman '748 patent clearly does not disclose or render obvious first and second lenses with an opening or aperture therethrough.

Furthermore, the Office action defines "concentric" to be "having a common axis" or "having a common center." Independent claims 41 and 49 recite that the second lens is substantially concentric with the first lens. The common center/axis shown in the Office action diagram is the center of the *assembled implant*. Independent claims 41 and 49 recite

that the second lens is concentric with the first lens, such that the common axis or center of *each* of the first and second lenses is substantially the same. The centers of the first and second arcuate portions shown in the Office action diagram are not substantially the same, but rather are significantly spaced from one another. Therefore, the Peyman '748 patent does not disclose nor render obvious a second lens substantially concentric with a first lens.

Furthermore, as recited in independent claim 41, the first and second lenses are substantially centered about the optical axis of the eye. The *assembled implant* of the Peyman '748 patent may be substantially centered about the optical axis of the eye. However, each of the arcuate portions of the implant is not centered about the optical axis of the eye. Instead, each of the arcuate portions is *radially spaced* from the optical axis of the eye. If each of the arcuate portions is modified to be substantially centered about the optical axis of the eye, the arcuate portions would be disposed on top of one another, thereby defeating the purpose of "modifying corneal curvature without operating on the center area of the cornea". Col. 3, lines 25 – 27. Thus, the Peyman '748 patent does not disclose or render obvious first and second lenses substantially centered about the optical axis of the eye.

Lacking several elements recited in independent claims 41 and 49, the Peyman '748 patent does not anticipate claims 41 and 49 since a "claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." Verdegall Bros. v. Union Oil Co. of California, 814 F.2d 628, 631 (Fed. Cir. 1987). Moreover, the Peyman '748 patent teaches away from the claimed invention, such that the claimed invention would not have been obvious in view of the Peyman '748 patent. Therefore, the Peyman '748 patent does not anticipate or render obvious independent claims 41 and 49.

Therefore, the Peyman '748 patent does not disclose or render obvious the claimed features of Applicant's invention, as recited in independent claims 41 and 49, such that independent claims 41 and 49 are allowable.

Claims 42 – 43 and 50, being dependent upon independent claims 41 and 49, respectively, are also allowable for the above reasons. Moreover, these dependent claims recite additional features further distinguishing them over the cited patents, such as placing at least one of the first and second lenses substantially concentrically about the optical axis of

the eye of claim 42; and the first lens portion having a refractive index different from the refractive index of the cornea of claim 50. Therefore, dependent claims 42 – 43 and 50 are not anticipated or rendered obvious by the Peyman '748 patent, particularly within the overall claimed combination.

CLAIM REJECTIONS UNDER 35 U.S.C. § 103(a)

In paragraphs 8 - 10, claims 44 – 48 and 51 are rejected under 35 U.S.C. § 103(b) as being unpatentable over the Peyman '748 patent, either alone or in combination with U.S. Patent No. 6,228,113 to Kaufman (the Kaufman '113 patent). Applicant respectfully traverses this rejection, since the Peyman '748 patent, either alone or in combination with the Kaufman '113 patent, clearly does not disclose, teach or render obvious the subject matter of claims 44 – 48 and 51.

The Kaufman '113 patent is cited for disclosing multiple lenses with power intervals from +5D to -5D at 0.25D intervals. However, the Kaufman '113 patent does not cure the deficiencies noted above in the Peyman '748 patent with respect to independent claims 41 and 49.

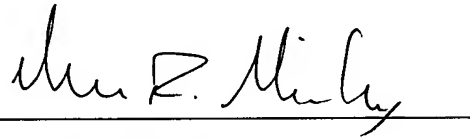
Therefore, claims 44 – 48 and 51, being dependent upon independent claims 41 and 49, respectively, are also allowable for the above reasons. Moreover, these dependent claims recite additional features further distinguishing them over the cited patents, such as the first and second lenses having a thickness of about 2 – 3 microns of claim 44; and the second inner diameter is about one millimeter larger than the first outer diameter of claim 51. Therefore, dependent claims 44 – 48 and 51 are not anticipated or rendered obvious by the Peyman '748 patent, either alone or in combination with the Kaufman '113 patent, particularly within the overall claimed combination.

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In view of the foregoing amendments and comments, Applicants respectfully submit that claims 41 – 47 and 49 - 51 are in condition for allowance. Prompt and favorable action is solicited.

Respectfully Submitted,



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